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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,980	12/19/2001	Jung-wan Ko	1293.1071D3	1189

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EXAMINER

PSITOS, ARISTOTELIS M

ART UNIT

PAPER NUMBER

2653

DATE MAILED: 09/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/020,980

Applicant(s)

KO ET AL.

Examiner

Aristotelis M Psitos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 27 June 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. Applicants' response of 6/27/02 has been considered with the following results.

Although applicants' identify the present application as a divisional of Sn 09/333,520 this examiner has been unable at the present time to review the file of that application. Hence this examiner is not certain whether this is a voluntarily filed divisional or one filed in response to a restriction requirement. If this is a voluntarily filed application, applicants' cooperation in reviewing the claims to ensure that there is no conflicting claims necessitating and obvious double patent rejection is respectfully requested.

Information Disclosure Statement

The IDS of 12/19/01 is acknowledged; however, none of the foreign documents cited therein have been reviewed. (No copies have been supplied). If applicants desire such documents to be considered, copies of such must be submitted.

The IDS of 6/5/02 has been received and entered. Note the examiner has only reviewed the patents to Furukawa and Maeda et al.

The listed pending applications HAVE NOT BEEN REVIEWED IN DETAILED – due to internal USPTO inventory restriction. Furthermore, it is noted that applicants' do not desire such to be printed if and when this application matures into a patent. Hence the examiner WILL NOT INITIAL those documents.

Applicants' cooperation in maintaining a clear line of demarcation between the pending claims in this application and those in the other applications is respectfully requested. Applicants are in a better position to determine what invention they desire protection of in which application.

Nevertheless, in order to assist applicants in their analysis, the examiner submits the following observations with respect to MEDIA CLAIMS:

- a) 09/335520 – media claims 1-24: POSSIBLE CONFLICTING CLAIMS
- b) 09/610695 – media claims 1-24: AGAIN POSSIBLE CONFLICTING CLAIMS
- c) 09/10/020945 – media claims 1-3: AGAING POSSIBLE CONFLICTING CLAIMS

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Drawings

2. The amendments to the figures are greatly appreciated by the examiner. These corrections are approved, and corrected drawings are NOW REQUIRED in reply to this Office action to avoid abandonment of the application.

In response to applicants' arguments with respect to figure 10, the examiner concludes that this figure is that of acknowledged prior art, and hence requires such a labeling. If this is not a correct conclusion, applicants' further analysis is respectfully requested.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, in the independent claim recites a product/ record medium. Unfortunately, claim 4 attempts to redefine the product in method language – a desired use – “when the writing protection information read ...” and as such not only fails to further define the parent claim – a 35 USC 112 paragraph 4 problem, but also is not understood since a method limitation cannot further define a product. Hence claim 4 fails to satisfy current USPTO practice. NO ART IS DEVELOPED WITH RESPECT TO CLAIM 4 because the examiner is not sure what applicants' would like to protect.

Response to Arguments

Applicants' arguments filed 6/27/02 have been fully considered but they are not persuasive. The examiner maintains his position. The examiner interprets the limitation(s) of claim 4 as an attempt to redefine a product by a method of use, which is both improper under present USPTO dependent claim practice, but also fails to define the product of claim 1. At the very least one would require the appropriate steps and apparatus to read the information in order to perform the desired result(s).

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AS FAR AS THE REMAINING CLAIMS ARE UNDERSTOOD AND INTERPRETED BY THE EXAMINER THE FOLLOWING ART REJECTIONS ARE MADE.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1,2 and 8 are rejected under 35 U.S.C. 103 as being obvious over either EP 1052639 or Kuroda et al further considered with Ro et al.

With respect to claim 1, Kuroda et al discloses a DVD disc, wherein the basic designated areas exist – lead in, lead out, user data area. Applicants' use of the next term RMA and RMD DOES NOT DEFINE OVER Kuroda et al – note that the EPA document uses the term RMD to define recording

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management data area. Hence the examiner concludes that both the claimed RMA and RMD limitations is not only inherently present but is merely a colorful use of language that does not patentable distinguish over the document. As is well known, "a rose by any other name would still smell as ...".

Looking at Kuroda et al, again, Lead in, lead out, user data area is depicted, as is RMD – note figure 9 for instance. Hence again, the examiner concludes that both the claimed terms RMA and RMD are inherently PRESENT.

With respect to the desired ability of having write protection information stored accordingly, applicants' attention is further drawn to Ro et al, which provides for the ability of having write protection in this environment. It appears from the description that the write protection information is in the lead in area of the disc.

It would have been obvious to modify the base system of of either the EP document or Kuroda et al with the above teaching from Ro et al to provide for write protection information for the further ability of write protection. The placement of this information into the specified area noted in the claim is considered merely a relocation of this signal. That is, from a lead in area to a management area. The normal understanding of management area is that of an area to store/hold/designate information about the record medium indicative thereof. To place an indication of copy protect from one area into another is not considered patentable. As known in this field placement of information control signals into various locations are well known – see both McFerrin et al - at col. 9 lines 10 plus – placement of a write start signal at the appropriate location, and Curtis et al - see col. 4, lines 40 plus which as stated in the previous Office action the ability of having a write protect information. Placement of this type of information is considered MERELY A DESIGN CHOICE and obvious to one of ordinary skill in the art.

Placement of such information in a MANGEMENT AREA is logical. Placement of this MANAGEMENT AREA in applicants termed – RMA is equally logical.

Since both the base references deal with DVD discs, obviously the limitations of claim 2 are inherently present.

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Furthermore, since neither document specifies that the disc be in a protective device, the limitations of claim 8 are considered inherently present. Alternatively, it is noted that the Ro et al document is a naked disc.

9. Claims 2, 3, 5, 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art applied to claim 1 above, and further in view of the acknowledged Prior Art and either McFerrin et al or Curtis et al. .

With regards to claim 2, the examiner interprets the DVD-RW specification to refer to the version 1.0 and version 1.9 as acknowledged as being prior art in applicants' disclosure.

With respect to claim 3, since McFerrin et al permits his recording of the protection signal to be at the start of a sector, and there can be a plethora of sectors, the duplication is inherently present. Also, so does Curtis et al provide for such plural recording positions.

With regards to claim 5, the examiner considers these limitations to refer back to the acknowledged Prior Art with regards to figure 3. Additionally, it is noted that the EP document also provides for the defect management ability.

With regard to claim 6, since the McFerrin document discloses that the information format of his record comprises a plurality of bands, the fields are grouped with the same write protection information as recited.

With respect to claim 8 there is no cartridge disclosed for encompassing the disk of McFerrin.

It would have been obvious to one of ordinary skill in the art to modify the base reference of McFerrin with the teaching(s) from the acknowledged Prior Art, motivation is to take its vantage of existing disk formats available to those of ordinary skill in the art and therefore save valuable resources in reading inventing limitations that already exist.

10. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 1 above, and further in view of McFerrin et al.

With regards to the limitations of claim 7, applicants' attention is drawn to the formats identified in figures 6 through 11 of the McFerrin document. As noted therein different bytes in different segments are reserved for special features. Although no specific byte is designated as the write protect indicator, the

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use of a designated byte for such a function is considered merely a selection of alternative equivalents. That is, the use of a byte and its position for control functions is well known as discussed by McFerrin. The selection of a particular byte for a designated function as opposed to a different function is up to a particular user's choice. No unexpected results are seen to occur from the selection of one byte position over another.

11. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 1 above, and further in view of either Heo or Maeda et al ('759).

The particular bit location, bp3, bp0, etc. as found in this claim is considered to be obvious over the DVD formats of either Heo or Maeda et al – both of which indicate such nomenclature is known when identifying sections of the dvd formats, see figures 8b, 9d, 16 17b, 18b and c in Heo which uses such bit designation for a plurality of uses – note in particular the use for designating attributes of the information.

Also, Maeda et al with respect to the DVD control data and TOC nomenclature.

It would have been obvious to modify the base system as identified above with respect to claim 1 and further use the nomenclature/language of DVD formats and place the control information at the desired location.

Placing of control information at the particular bit positions is considered merely design expediency as long as such does not conflict with previously used bit positions.

12. Claims 1, 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Kuroda et al or EP 1052539 and further considered with Nozaki et al.

Kuroda et al, EPA 1052639 are relied upon for the reasons stated above in paragraph 8.

Nozaki et al provides for copy protection information signals – see figure 6 and its disclosure for instance. This is control information, which the examiner concludes is placed in the root directory of the disc. The root directory of a disc is normally placed in a MANAGEMENT AREA. To call this management area a RMA as does applicants is not considered of patentable weight.

It would have been obvious to modify the base system of either Kuroda et al or EP 1052639 with the above teaching from Nozaki et al motivation is to provide for appropriate copy protection as desired by a user.

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The disc is naked in Nozaki et al and this is a DVD environment as are the primary references, hence the limitations of claims 2 and 8 are considered present.

13. Claims 2, 3,5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 1 has stated above in paragraph 12, and further in view of the acknowledged Prior Art

The acknowledged prior art meets the limitations of claims 2, 3,5 and 6.

It would have been obvious to modify the base system of the references relied upon in paragraph 12 with the additional well known abilities of the prior art to ensure compatibility with existing DVD formats.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 1 as stated in paragraph 12 above, and further in view of either Heo or Maeda et al ('759).

The particular bit location, bp3, bp0, etc. as found in this claim is considered to be obvious over the DVD formats of either Heo or Maeda et al – both of which indicate such nomenclature is know when identifying sections of the dvd formats, see figures 8b, 9d, 16 17b, 18b and c in Heo which uses such bit designation for a plurality of uses – note in particular the use for designating attributes of the information.

Also, Maeda et al with respect to the DVD control data and TOC nomenclature.

It would have been obvious to modify the base system as identified above with respect to claim 1 and further use the nomenclature/language of DVD formats and place the control information at the desired location.

Placing of control information at the particular bit positions is considered merely design expediency as long as such does not conflict with previously used bit positions.

Response to Arguments

Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Satoh et al, Lee et al, Itami et al for disclose copy protection attributes, DVD formats, and defect management abilities in this environment.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M Psitos whose telephone number is (703) 308-1598. The examiner can normally be reached on M-Thursday 8 - 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (703) 305-6137. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

Aristotelis M Psitos
Primary Examiner
Art Unit 2653



AMP
August 30, 2002